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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,560	03/15/2004	William H. Brine III	SHI 64963	9795

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EXAMINER

CHAMBERS, MICHAEL S

ART UNIT PAPER NUMBER

3711

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/800,560

Applicant(s)

BRINE ET AL.

Examiner

Mike Chambers

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-20 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-15,17-20 and 25-29 is/are rejected.
- 7) ☒ Claim(s) 16 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 13-15, 17-18, and 25-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Bolduc et al (6783471). Bolduc discloses

a lacrosse stick handle; and a lacrosse head connected to the lacrosse stick handle; and an articulation mechanism disposed between the lacrosse stick handle and the lacrosse stick head (fig 10, 1:7-11, 8:1-14, 8:53-65).

As to claim 2 : Bolduc discloses a head is connected to the handle by an articulation mechanism (8:53-65).

As to claim 3 : Bolduc discloses an articulation mechanism that is located between an end of the handle and a base of the head (fig 10, 8:53-65).

As to claim 5 : Bolduc discloses an articulated mechanism that is contained within the head and handle (fig 10, 8:53-65).

As to claim 13 : The device of Bolduc would inherently articulate in direction in which the ball would exit due to the physics and movement of the ball and head.

As to claim 14: Bolduc discloses a first and second element (fig 10, item 40,43).

As to claim 15 : Bolduc discloses a fastener (fig 10, item 44).

As to claim 17 : Bolduc discloses a resistive material (fig 10, 6:24-28).

As to claim 18 : Bolduc discloses a polymeric material (6:24-26).

As to claim 25: Bolduc discloses a locking mechanism for restricting the flexure (fig 10, item 48).

As to claim 26: See claim 1 rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,3,5-13,26 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burnett (GB1589596) in view of Kennedy (0537927). Burnett discloses the elements of claim 1 (fig 1, 4:50-55) however it fails to clearly disclose the use of an articulation mechanism. Kennedy discloses the use of an articulation mechanism (fig 4,1:10-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the articulation mechanism of Kennedy with the apparatus of Burnett in order to reduce the impact to the players hands when catching the ball.

As to claims 2 and 3 : Burnett discloses a head is connected to the handle (fig 1). Due to the playing position of the hands, the natural position for the articulation mechanism is between the head and handle.

As to claim 5 : Kennedy discloses an articulated mechanism that would be contained within the head and handle (fig 4).

As to claims 6-13 : See claim 1 rejection. Kennedy discloses an articulated mechanism that would articulate in all 360 degrees around the centerline axis (fig 4). The specification fails to disclose any surprising or unanticipated results from the displacement angles claimed, therefore they are considered design choices.

As to claim 26 : See claim 1 rejection.

As to claims 28 and 29: See claim 1 rejection.

Also,

Claims 6-9 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolduc as applied to claim 1 and 26 above. The articulation of the device would naturally have a displacement angle since the head deviates from the centerline axis. The specification provides no unexpected or surprising results in using the angled displacements claimed, therefore the ranges of displacement claimed are considered design choices. It would have been obvious to one of ordinary skill in the art to have selected an appropriate angle of articulation based on personal preference, materials and marketing design considerations.

As to claims 27-29: See claims 6-9 rejections.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolduc as applied to claim 1 above. The articulation of the device would naturally have a displacement angle since the head deviates from the centerline axis. The specification provides no unexpected or surprising results in using the angled displacements claimed, therefore the ranges of displacement claimed are considered design choices. It would have been obvious to one of ordinary skill in the art to select an appropriate angle of articulation based on personal preference, materials and marketing design considerations.

Also,

Claims 1,2,5-15,17,19-20, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brine (3910578) in view of Hubbard (303517). Brine discloses the elements of claim 1, however it fails to clearly disclose the use of an articulation mechanism. Hubbard discloses the use of an articulation mechanism (fig 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the mechanism of Hubbard with the apparatus of Brine in order to customize the lacrosse head to the personal head angle preferences of the user preferences of the user and increase the satisfaction of the user.

As to claim 2 : Hubbard discloses a head connected to the handle by an articulation mechanism (fig 2).

As to claim 3 : Hubbard discloses an articulated head is connected to the handle by an articulation mechanism (fig 2).

Art Unit: 3711

As to claim 5 : Hubbard discloses an articulated mechanism that is contained within the head and handle (fig 2).

As to claim 6 : Hubbard discloses a moveable head (fig 2).

As to claims 7-9 : Hubbard discloses a displacement angle (fig 2). The movement of the ball and socket joint would include all the limitations claimed.

As to claim 10 : Hubbard discloses a first and second displacement angles (fig 2). The movement of the ball and socket joint would include all the limitations claimed.

As to claim 11 : Hubbard discloses a first and second displacement angles that are the same (fig 2). The movement of the ball and socket joint would include all the limitations claimed.

As to claim 12 : Hubbard discloses a first and second displacement angles that are different (fig 1,4). The movement of the ball and socket joint would include all the limitations claimed.

As to claim 13 : Hubbard discloses a head that articulates in the same direction as a ball exiting the device (fig 2).

As to claim 14 : Hubbard discloses a first and second element (fig 2).

As to claim 15 : Hubbard discloses a fastener (fig 2).

As to claim 17 : Hubbard discloses a resistive material (fig 2).

As to claims 19 and 20 : Hubbard discloses a ball and socket assembly (fig 2).

As to claim 25 : Hubbard discloses a locking mechanism (fig 2).

As to claim 26 : See claim 1 rejection.

As to claims 27-29 : See claim 7-9 rejection.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brine (3910578) in view of Hubbard (303517) as applied above and further in view of Official Notice . Official Notice was taken in the prior action that the use of various resistive materials is well known in the art. The specification provides no unexpected or surprising results in using any of the materials claimed. It would have been obvious to one of ordinary skill in the art to have selected an appropriate resistive material based on cost and design considerations.

***Allowable Subject Matter***

Claims 16, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. Applicant has argued that Hubbard is non-analogous art. The examiner does not agree with this statement. Hubbard discloses an article with a handle, an attachment means and an attachment. One of ordinary skill in the art would have selected any one of several equivalent means of attachment, including a ball and socket type attachment. The knowledge of various means of attachment would be known to one of ordinary skill and that knowledge would be used in selecting the attachment means. As noted in the CAFC case---



In re Sovish, Moisson, and Selleslags (CAFC 226 USPQ 771 July 26, 1985, 85-781) the court found the argument that the propriety of combining references was proper for one skilled in the art:

Appellants have argued at length about the "propriety" of "combining the two references" as though the question is simply whether the Esher patent suggests within its four corners using the disclosed tubular, closed-end plug in a heat recoverable aperture member or conduit or whether Weagant similarly suggests using art Esher type plug in place of cork-like plug 26. That is not the proper approach to the issue, which is whether the hypothetical person of ordinary skill in the relevant art, familiar with all that Esher and Weagant disclose, would have found it obvious to make a structure corresponding to what is claimed. See *Kimberly-Clark Corp. vs. Johnson & Johnson*, 745 F.2d 1437, 1449, 223 USPQ 603 610 (Fed. Cir. 1984). We conclude that such hypothetical person would have found obvious what claim 1, for example, delineates, applying such "ordinary skill" as he (or she) is presumed to possess. Finally, appellants contend that even if it were proper to "combine" the references, whatever they may mean by that, they would "neither meet the terms of the appealed claims nor result in a useful device." The question here, however is not meeting the terms of the claims. The rejection is for obviousness of what is claimed, which involves consideration of the ordinary skill of the art. As for resulting in a useful device, appellants are talking about Esher's plug not being removable and being left in the conduit, which, they say, "would prevent effective heat recovery." They are assuming that one of ordinary skill would not appreciate that Esher's hollow member 14 could be removed if it is not wanted, a insulation or otherwise, and that it would not be removed by a skilled worker who wished to allow heat recovery of the conduit in which it was placed. This argument presumes stupidity rather than skill.

The decision of the board is affirmed

The indication of allowability of some of the dependent claims shows that with additional structure, there are allowable claims in the application.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

Art Unit: 3711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272- 4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

0303517\*6241629\*3910578\*RE38216\*6752730

Michael Chambers  
Examiner  
Art Unit 3711

October 11, 2006



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SUPERVISORY PATENT EXAMINEE